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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,916	12/16/2003	Liliane Goetsch	017753-183	5622
21839	7590	10/23/2006		
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			EXAMINER HUYNH, PHUONG N	
			ART UNIT 1644	PAPER NUMBER

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,916

Applicant(s)

GOETSCH ET AL.

Examiner

Phuong Huynh

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006 and 03 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,18-21,30 and 55-76 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 and 66-73 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,30,55,56,58-61,65 and 74-76 is/are allowed.
- 6) ☒ Claim(s) 57 and 62 is/are rejected.
- 7) ☒ Claim(s) 63 and 64 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/27/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. -See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 18-21, 30 and 55-76 are pending.
2. Claims 18-21 and newly added claims 66-73 are withdrawn from further consideration by the examiner, 37 C.F.R. 1.142(b) as being drawn to non-elected inventions.
3. Claims 1, 30, 55-65 and 74-76 drawn to an isolated antibody, or binding fragment thereof that binds human insulin-like growth factor I receptor, a hybridoma producing said antibody, a process of producing antibody that binds specifically human insulin-like growth factor I receptor, a composition comprising said antibody or functional fragments thereof and a pharmaceutically acceptable carrier, and a kit comprising said antibody, are being acted upon in this Office Action.
4. The following new grounds of rejection are necessitated by the amendment filed 7/27/06 and 7/3/06.
5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claims 57 and 62 are rejected under 35 U.S.C. 112, first paragraph, containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection.**

The antibody....the light chain ...(CDR) *further comprises* SEQ ID NO: 54 and the heavy chain ...(CDR) *further comprises* SEQ ID NO: 69 in claim 57 represents a departure from the specification and the claims as originally filed. This is because SEQ ID NO: 54 is an immunoglobulin light chain that already comprises the three light chain complementarity determining region (CDRs). Likewise, SEQ ID NO: 69 already comprises the heavy chain complementarity determining region (CDRs). The specification as filed does not teach any antibody or fragment thereof of claim 1 comprising more than *six* CDRs (three from the light chain and three from the heavy chain) as now claimed. It is suggested that claim 57 be amended

Art Unit: 1644

to recite "The isolated antibody or a binding fragment thereof of claim 1 wherein the antibody comprises an immunoglobulin light chain comprising the amino acid sequence of SEQ ID NO: 54 and an immunoglobulin heavy chain comprising the amino acid sequence of SEQ ID NO: 69.

The antibody ...wherein the light chain *further comprises* SEQ ID NO: 61 or 65 and the heavy chain ...(CDR) *further comprises* SEQ ID NO: 75, 79 or 83 in claim 62 represents a departure from the specification and the claims as originally filed. This is because SEQ ID NO: 61 or 65 is an immunoglobulin light chain that already comprises the light chain complementarity determining region (CDR). Likewise, SEQ ID NO: 75, 79 or 83 already comprises the heavy chain complementarity determining region (CDR). The specification as filed does not teach any antibody or fragment thereof of claim 1 comprising more than *six* CDRs (three from the light chain and three from the heavy chain) as now claimed. Amendment to the claim as suggested above would obviate this rejection.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claim 62 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "light chain" and "heavy chain" in claim 62 have no antecedent basis in base claim 1. This is because base claim 1 does not recite the term "light chain" and "heavy chain" as a full-length immunoglobulin light chain or a full-length heavy chain immunoglobulin. The light chain complementarity determining region (CDR) comprising SEQ ID NO: 2, 4 and 6 are the binding domain of the antibody. The heavy chain complementarity determining region (CDRs 1-3) comprising SEQ ID NO: 8, 10 and 12 are the binding domain of the claimed antibody or binding fragment thereof.

9. Claims 1, 30, 55-56, 58-61, 65 and 74-76 are allowed.
10. Claims 63-64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1644

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Huynh "NEON" whose telephone number is (571) 272-0846. The examiner can normally be reached Monday through Friday from 9:00 am to 5:30 p.m. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The IFW official Fax number is (571) 273-8300.
12. Any information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuong N. Huynh, Ph.D.

Patent Examiner

Technology Center 1600

October 13, 2006


CHRISTINA CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600